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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,659	12/02/2003	Karin Golz-Berner	4034.003	5041
7590 PENDORF & CUTLIFF 5111 Memorial Highway Tampa, FL 33634-7356		11/15/2007	EXAMINER CHONG, YONG SOO	
			ART UNIT 1617	PAPER NUMBER
			MAIL DATE 11/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/725,659	Applicant(s) GOLZ-BERNER ET AL.	
	Examiner Yong S. Chong	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14, 16-19 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's arguments filed on 9/20/2007.

Claim(s) 1-11 have been cancelled. Claim(s) 12-23 are pending. Claim(s) 12-13 have been amended. Claim(s) 15, 20-22 have been withdrawn. Claim(s) 12-14, 16-19, 23 are examined herein.

Applicant's amendments have rendered the claim objection and the 112 rejections moot, therefore hereby withdrawn.

Applicant's arguments with respect to the 103(a) obviousness rejection has been fully considered but found not persuasive. The 103(a) rejection of the last Office Action are maintained for reasons of record and modified or repeated below for Applicant's convenience.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 12, 13 (in part), 14, 16-19, 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 14, 16 of copending Application No. 11/757,089 in view of Konikoff (US Patent 4,142,521).

Claims 12, 13 (in part), 14, 16-19, 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 14, 16 of copending Application No. 11/757,128 in view of Konikoff (US Patent 4,142,521).

Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the above claims discloses a cosmetic composition comprising fluorocarbons and/or vitamins, whereas the instant claims disclose a cosmetic composition comprising a polymerized fluorocarbon in the electret state and/or vitamins.

Konikoff teach the enhancement of soft tissue wound repair by electret-type materials, specifically the application of small electrical currents or weak magnetic or electrical fields. Such wounds include surgical incisions, abrasions, cuts, punctures, blemishes, tears, sores, blisters, burns, contusions, tissue ruptures, and the like (col. 1, lines 1-21). Konikoff also disclose that Teflon is a common material that can be made into electrets (col. 5, lines 25-36).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have substituted the electret

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state of Teflon as disclosed by Konikoff with the non-electret Teflon in the cosmetic compositions of the above applications.

A person of ordinary skill in the art would have been motivated to make this substitution because: (1) both Konikoff and the above applications is concerned with the field of dermatology, particularly treatment of the skin; (2) Konikoff discloses that Teflon is a electret material, which can enhance the skin by repairing skin blemishes, etc.; (3) therefore, the skilled artisan would have had a reasonable expectation of success in producing a cosmetic composition comprising electret Teflon for the skin.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

The terminal disclaimer filed on 9/20/2007 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Applications 10/474,093 and 10/574,069 has been reviewed and is accepted. The terminal disclaimer has been recorded. The obviousness double patenting rejections are hereby withdrawn.

Applicant argues that US Applications 11/757,089 and 11/757,128 are not pending, but were created in error. These applications are currently pending so therefore they are subject to double patenting rejections. Applicant is encouraged to either verify that these applications are not pending or to abandon these cases.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 12, 13 (in part), 14, 16-19, 23 are rejected under 35 U.S.C. 103(a) as being obvious over Nakane et al. (US Patent 5,122,418) in view of Konikoff (US Patent 4,142,521).

The instant claims are directed to a cosmetic composition comprising polymerized fluorocarbons, in the electret state, and Vitamin A or E.

Nakane discloses a composite cosmetic powder used for the skin (abstract). The resin powder is preferably Teflon with an average particle size of 1 to 100 microns (col. 10, lines 23-30). Additional components include vitamin A and E (sentence bridging col. 11 and 12, Example 23). Example 28 also discloses a cosmetic stick composition for sunburn comprising Teflon powder in an amount of 10%.

However, Nakane et al. fail to disclose specifically the electret state of Teflon.

Konikoff teach the enhancement of soft tissue wound repair by electret-type materials, specifically the application of small electrical currents or weak magnetic or electrical fields. Such wounds include surgical incisions, abrasions, cuts, punctures, blemishes, tears, sores, blisters, burns, contusions, tissue ruptures, and the like (col. 1, lines 1-21). Konikoff also disclose that Teflon is a common material that can be made into electrets (col. 5, lines 25-36).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have substituted the electret state of Teflon as disclosed by Konikoff with the non-electret Teflon in the cosmetic composition disclosed by Nakane.

A person of ordinary skill in the art would have been motivated to make this substitution because: (1) both Nakane and Konikoff is concerned with the field of dermatology, particularly treatment of the skin; (2) Nakane discloses a cosmetic composition comprising Teflon; (3) Konikoff discloses that Teflon is a electret material, which can enhance the skin by repairing skin blemishes, etc.; (4) therefore, the skilled artisan would have had a reasonable expectation of success in producing a cosmetic composition comprising electret Teflon for the skin.

Examiner notes that the limitations regarding the field strength and coercive force of the permanent electric dipole moment are considered inherent since a composition and its properties are inseparable.

“Products of identical chemical composition can not have mutual exclusive properties.” Any properties exhibited by or benefits from are not given any patentable weight over the prior art provided the composition is inherent. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the disclosed properties are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to the applicant to show that the prior art product does not inherently possess the same properties as the instantly claimed product.

It is also noted that limitations regarding the process set forth in claim 23 are given little patentable weight since it is a product by process claim. It is respectfully pointed out that even though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorp*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). “The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with

evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

Response to Arguments

Applicant argues that Konikoff teaches against the use of small particles, as disclosed by Nakane, in bandages since they must be self-contained. Applicant also argues nonobviousness since Konikoff deals with wound care devices, which are in a completely different field from the claimed cosmetic compositions.

This is not persuasive because Applicant has misinterpreted the obviousness rejection. The rejection does not state the use or modification of Konikoff's wound care devices. Applicant is reminded that it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have substituted the electret state of Teflon as disclosed by Konikoff with the non-electret Teflon in the cosmetic composition disclosed by Nakane.

A person of ordinary skill in the art would have been motivated to make this substitution because: (1) both Nakane and Konikoff is concerned with the field of dermatology, particularly treatment of the skin; (2) Nakane discloses a cosmetic composition comprising Teflon; (3) Konikoff discloses that Teflon is a electret material, which can enhance the skin by repairing skin blemishes, etc.; (4) therefore, the skilled artisan would have had a reasonable expectation of success in producing a cosmetic composition comprising electret Teflon for the skin.

Finally, Applicant argues that even if there were a motivation to combine the references, there would be no expectation that the claimed combination would produce enhanced absorption of active ingredients. Although Konikoff discloses that it is known that small electric currents improve wound repair, it states that the reason for this "remains unclear."

This is not persuasive because the fact that Konikoff discloses that it is known that small electric currents improve wound repair is more than enough to support a reasonable expectation of success in producing a cosmetic composition comprising electret Teflon for the skin. The fact that the exact mechanism is not clear yet has no bearing on the positive effect of small electric currents on the wound.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER